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| APPLICATION NO.         | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 09/833,339              | 04/12/2001  | Rabindranath Dutta   | AUS920010216US1     | 3779             |
| 35525                   | 7590        | 10/04/2005           | EXAMINER            |                  |
| IBM CORP (YA)           |             |                      | HARBECK, TIMOTHY M  |                  |
| C/O YEE & ASSOCIATES PC |             |                      | ART UNIT            |                  |
| P.O. BOX 802333         |             |                      | PAPER NUMBER        |                  |
| DALLAS, TX 75380        |             |                      | 3628                |                  |

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/833,339

Applicant(s)

DUTTA ET AL.

Examiner

Timothy M. Harbeck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/12/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/25/2005, 8/8/2005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "304" has been used to designate both a speaker and a keypad in Figure 3. Examiner believes that applicant intended for the speaker to be labeled "306" as noted in the specification and the application has been examined under this assumption. Nonetheless correction is required. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 13-22, 25-34 and 37-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson et al (hereinafter Stinson US Pat No 6,786,398) in view of Anderson et al (hereinafter Anderson US Pat No 6,021,202).

**Re Claim 1:** Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising

- Receiving a customer check issued by a customer at the automatic teller machine (Column 1, lines 58-61)
- Identifying an amount for the customer check (Column 1, lines 63-64)

Stinson does not explicitly disclose

- Creating a new check for the amount, wherein the funds for the amount are guaranteed by a financial institution

Anderson discloses a method and system for processing electronic documents wherein an electronic check (new check) can be initiated from an ATM machine (Column 22, lines 63-67), wherein the funds for the amount are guaranteed by a financial institution (Column 23, lines 5-11). Anderson notes that an electronic check in some respects mimics the paper check and is therefore authenticated and guaranteed by a financial institution (bank).

It would have been obvious to someone skilled in the ordinary art at the time of invention to include the teachings of Anderson to the disclosure of Stinson so that a customer using an ATM, could sign over a check (forward a payment), representing a certain value, to another individual or organization even if the other individual or organization is not present to accept the physical check.

**Re Claim 2:** Anderson further discloses the step comprising verifying funds are available in an amount for the customer prior to creating the new check (Column 23, lines 50-54).

**Re Claims 3 and 4:** Stinson in view of Anderson discloses the claimed method supra, and while the references do not explicitly disclose the step of dispensing the new check to the customer, Stinson does disclose an apparatus with dispensing means (See Abstract). While the Stinson disclosure specifically discusses the dispensing of cash from the apparatus, it would have been obvious to someone skilled in the ordinary art at the time of invention to adapt the apparatus of Stinson to dispense equivalent alternatives to cash, such as cashiers checks or traveler's checks. An individual might wish to use these alternatives instead of cash for a variety of reasons, including if they were traveling and did not want to carry large amounts of cash for fear of losing the money. If a person loses a check, the individual can simply cancel said check and be assured that the funds will return to their account. The same cannot be said if a person loses cash. Alternatives to cash are very popular and therefore it would be useful for an ATM machine to dispense these alternatives as well.

**Re Claim 5:** Stinson in view of Anderson discloses the claimed method supra and Anderson further discloses the step comprising sending the check to a third party designated by the customer (Column 23, lines 31-56).

**Re Claim 6:** Anderson further discloses wherein the new check is sent to the third party as an electronic check (Column 23, lines 54-56).

**Re Claim 7:** Stinson discloses a method for processing checks comprising:

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- Receiving a check from a customer at the automatic teller machine  
(Column 1, lines 58-61)

Stinson does not explicitly disclose the steps of

- Scanning a check to create an image of the check
- Searching the image of the check for a digital watermark
- Responsive to identifying the digital watermark in the image, determining whether the digital watermark is authentic; and
- Responsive to the digital watermark being authentic, providing financial services to the customer

Anderson discloses a method and system for processing electronic documents that discloses the creation and authentication of electronic checks, including check imaging and scanning (Column 7, lines 40-49). In this system, an electronic check is created by a payer and digitally signed before being sent to a payee (Column 23, lines 50-56). The payee then digitally signs the electronic check and then forwards this to the respective banks (Column 23, lines 57- 64). The payers bank then validates the signatures and also “verifies that the instrument is not a duplicate,” and if there are sufficient funds to cover the check, the payers bank debits the payers account (thus providing a financial service) and sends payment to the payees bank (Column 24, lines 29-36).

While Anderson does not explicitly disclose the term ‘digital watermark,’ this term is simply a broad term used to determine if a check is a duplicate of a previous check. Before electronic checks, it was well known in the art at the time of invention that paper

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checks were outfitted with watermarks to prevent the fraudulent copying, and subsequent cashing of the same check more than once. A “digital” watermark is therefore simply an electronic way to perform the same function. As previously stated, Anderson discloses that the payer’s bank, during the authentication process “verifies that the instrument is not a duplicate” (Column 24, lines 28-29) therefore disclosing the searching, identifying and authenticating of a “digital watermark,” specifically using a markup language (Column 3, lines 13-19). Once this is done, the system of Anderson provides financial services to the customer.

It would have been obvious to someone skilled in the ordinary art at the time of invention to include the teachings of Anderson to the disclosure of Stinson so that a person at an automated teller machine would have the ability to transform a paper check into an electronic version, without sacrificing any security measures, and send it to a third party recipient. This would save time in that the parties would not have to wait for the check to be mailed and for the recipient to take said check to an appropriate place (i.e. bank) for settlement.

**Re Claim 8:** Stinson in view of Anderson discloses the claimed method *supra* and Anderson further discloses the step comprising

- Identifying a financial institution for an account on which the check is issued (Column 24, lines 11-20)
- Comparing the digital watermark identified in the image to a watermark associated with the financial institution to see if a match occurs, wherein the watermark is authentic if the match occurs (Column 24, lines 28-30).

The use of a watermark, in paper checks, is to prevent duplication of a single check. A "digital" watermark is used for electronic checks in the same manner. Anderson discloses that the bank "verifies the instrument is not a duplicate," which implies that the digital watermark, has been compared to an appropriate watermark associated with the financial institution.

**Re Claim 9:** Stinson in view of Anderson discloses the claimed method supra and Anderson further discloses the step of determining whether funds are available in an account from which the check was issued to cover an amount of the check (Column 24, lines 31-33)

**Re Claim 10:** Stinson in view of Anderson discloses the claimed method supra and Anderson further discloses the step of initiating a funds transfer for the amount of the check in response to a determination that funds are available to cover the amount of the check (Column 24, lines 31-37).

**Re Claims 13-22:** Further data processing system would have been necessary to perform previously rejected method claims 1-10 respectively and are therefore rejected using the same art and rationale.

**Re Claims 25-34:** Further data processing system would have been necessary to perform previously rejected method claims 1-10 respectively and are therefore rejected using the same art and rationale.



**Re Claims 37-46:** Further computer program product would have been necessary to run previously rejected method claims 1-10 respectively and are therefore rejected using the same art and rationale.

Claims 11-12, 23-24, 35-36 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson in view of Lemelson (US Pat No 4,991,205).

**Re Claim 11:** Stinson discloses a method and apparatus for automatic cashing of a negotiable instrument comprising

- Verifying an identification of the user (Column 1 line 67- Column 2 line 2)
- Responsive to the identification of the user being verified, capturing an image of the user and retrieving user information associated with the user (Column 2, lines 14-34)

Stinson does not explicitly disclose the steps wherein this information is stored on an identification card and this card is generated at the automatic teller machine.

Lemelson discloses a personal identification system and method wherein one object is to "provide a credit card recording and reproduction system for rapidly and easily recording signals relating to a physical characteristic of the card owner on the card which recording may be reproduced by specialized equipment and employed to generate images of the face and signature of the card owner. (Column 1, line 65- Column 2, line 2)" It would have been obvious to someone skilled in the ordinary art at the time of invention to include the identification card taught by Lemelson to the biometrics verification method of Stinson so that a large central database of names

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does not need to be kept and referenced every time a person uses an ATM. If the data is stored on an individual card, provided by the user, then the system need only to read the information on the card, therefore saving memory space and money.

While the references do not explicitly disclose that the automated teller machine generates the identification card, this would have been obvious to anyone skilled in the ordinary art so that someone using an ATM for the first time could have an identification card produced for them for future visits so they do not have to waste time in proceeding through a longer verification process for each subsequent visit. Producing the card at the ATM vestibule is advantageous as well as a customer can simply perform this action once before an initial transaction as opposed to having to go out of the way to a central office to have a card generated.

**Re Claim 12:** Stinson in view of Lemelson discloses the claimed method supra and while not explicitly disclosing the step of dispensing the identification card to the user, as explained previously in Claim 11, the advantage of having the ID card generated at the ATM vestibule would be that a customer would not have to go out of the way to a central office to receive their ID card, but rather could take a few extra minutes before a transaction and have one generated. The same reasoning applies to having the card dispensed on site. Stinson has means for dispensing, as well as means for reading cards, so it would be obvious to someone skilled in the ordinary art to adapt the apparatus to dispense identification cards as well.

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**Re Claims 23 and 24:** Further data processing system would have been necessary to perform previously rejected method claims 11 and 12 respectively and are therefore rejected using the same art and rationale.

**Re Claims 35 and 36:** Further data processing system would have been necessary to perform previously rejected method claims 11-12 respectively and are therefore rejected using the same art and rationale.

**Re Claims 47 and 48:** Further computer program product would have been necessary to run previously rejected method claims 11 and 12 respectively and are therefore rejected using the same art and rationale.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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